

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional): P3C1-US	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO at (571) 273-8300 or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on <u>February 6, 2007</u> .  _____ Erin Cowles	Application Number: 10/035,633	Filed: December 28, 2001	
	First Named Inventor: Eldridge et al.		
	Art Unit: 3729	PTO: Carl J. Arbes	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).          Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div> <input type="checkbox"/> applicant/inventor.   <input type="checkbox"/> assignee of record of the entire interest.  <small>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</small>   <input checked="" type="checkbox"/> attorney or agent of record.            Registration number: <u>39,923</u>   <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34: <u>39,923</u> </div> <div style="text-align: right;"> <u>N. Kenneth Burraston/</u>            Signature   <u>N. Kenneth Burraston</u>            Typed or printed name   <u>(801) 323-5934</u>            Telephone number   <u>February 6, 2007</u>            Date         </div> </div> <p>Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☐ \*Total of \_\_ form(s) are submitted.

**ARGUMENTS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In support of Applicants' Pre-Appeal Brief Request For Review of the final rejection in the Office Action dated September 7, 2006 (hereinafter the "Office Action Under Appeal") in the above-identified patent application, Applicants respectfully submit the following:

**I. Background:**

In an After Final Amendment filed on August 2, 2006, Applicants amended the claims in this application to include only those claims identified in the preceding final Office Action dated June 19, 2006 as allowable. In the Office Action Under Appeal (issued on September 7, 2006), the U.S. Patent and Trademark Office ("PTO") withdrew all the then pending rejections but rejected all the claims on new grounds of non-statutory, obvious-type double patenting in view of all 69 claims from U.S. Patent No. 5,476,211 ("the '211 Patent"). Although Applicants are aware that an obvious-type double patent rejection can be overcome by simply filing a terminal disclaimer, Applicants are concerned about possible long term detrimental effects to the patent that issues from this application should Applicants fail to assert that the subject matter of the claims in the instant application are patentable over the claims in the '211 Patent.

In other words, Applicants assert that the subject matter of the claims of the instant application is novel and non-obvious whether compared to the claims of the '211 Patent or to prior art. Applicants therefore assert that the double patenting rejection is in error, yet should the double patenting rejection not be withdrawn, the novel, non-obvious subject matter of the claims of the instant application could be, for the life of the patent that issues from this application, incorrectly viewed as a mere obvious variation of prior work. For this reason, Applicants file this Pre Appeal Brief Request For Review in order to assert and preserve the novel and non-obvious status of the subject matter of the claims of this important patent application. Applicants thus request careful and thorough review and then withdrawal of the double patenting rejection.

## II. Argument:

As with all rejections, the initial burden of establishing a *prima facie* case of obvious-type double patenting is on the PTO. (See MPEP § 804, subsection on pp. 800-21 and 800-22 entitled "1. Obviousness-Type.") Moreover, to establish a *prima facie* case of obvious-type double patenting, the PTO must both (1) identify differences between the claims in the pending application and the claims of the prior patent and (2) establish that a person of ordinary skill in the field would conclude that the claims in the pending application are obvious in view of the claims of the prior patent. (MPEP § 804, subsection on pp. 800-21 and 800-22 entitled "1. Obviousness-Type.") Thus, in this case, the PTO must (1) identify differences between claims 375, 380, 381, and 383-428 pending in this application and claims 1-69 of the '211 Patent, and (2) establish that a person of ordinary skill in the field would conclude that those differences are obvious. As discussed below, the PTO has done neither and has therefore not established a *prima facie* case of obvious-type double patenting.

The only justification provided by the PTO for the obvious-type double patenting rejection is that "the claimed contact assembly can be fabricated by fabricating a plurality of structures on a sacrificial substrate, providing a substrate comprising an array of electrical connections, attaching ones of the contact structures to ones of the array of electrical connections and removing the contact structures from the sacrificial substrate." (Office Action Under Appeal, pp. 2-3.) The foregoing statement, however, does not identify differences between claims 375, 380, 381, and 383-428 pending in the application and claims 1-69 of the '211 Patent much less establish that such differences are obvious. For this reason alone, the PTO has not established a *prima facie* case of obvious-type double patenting, and the rejection should accordingly be withdrawn.

Moreover, the obvious-type double patenting rejection should be withdrawn for at least the additional reason that the PTO premised the rejection on the incorrect conclusion that the contact assemblies recited in claims 375, 380, 381, and 383-428 of the instant application can be made using a process like the processes of claims 1-69 of the '211 Patent. As discussed below, however, the processes of claims 1-69 of the '211 Patent are mutually exclusive of the processes recited in the claims of the instant application. Therefore, contrary to the conclusion by the PTO, a process like the processes recited in claims 1-69 of the '211 Patent cannot be used to make the contact assemblies of the claims of the instant application.

More specifically, in each of the independent claims in the '211 Patent, a contact is fabricated on *both* an electronic component (which the PTO presumably equated with the substrate of claims 375, 380, 381, and 383-428) and a sacrificial substrate. For example, in claim 1 of the '211 Patent, a contact is fabricated by bonding ends of a wire *both* to a terminal of the electronic component and to a sacrificial substrate. Thus, in the claims of the '211 Patent, the attachment of a contact to the electronic component occurs *before* the contact is fully fabricated. Indeed, attachment to the electronic component is part of the process of fabricating the contact.

In contrast, in each of the independent claims pending in the instant application, a contact structure is not attached to the final substrate until *after* the contact structure has been fabricated on the sacrificial substrate. For example, claim 375 recites "fabricating a plurality of contact structures," and "*after said fabricating step . . .*, attaching ones of said plurality of contact structures to ones of said array of electrical connections." Each of independent claims 392, 401, and 404 include similar recitations. The processes recited in claims 1-69 of the '211 Patent—which, as discussed above, attach a contact to the electronic component as part of the process of making the contact and thus before the contact is fabricated—cannot be used to make the contact assemblies of claims 375, 380, 381, and 383-428 of the instant application.

The PTO's premise that a process like the processes recited in claims 1-69 of the '211 Patent can be used to make the contact assemblies of the claims of the instant application is thus incorrect. For at least this additional reason, the obvious-type double patenting rejection should be withdrawn.

### **III. Conclusion:**

In view of the foregoing, Applicants respectfully request that the rejection of claims 375, 380, 381, and 383-428 be withdrawn and all pending claims allowed.